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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,175	07/30/2001	Xiaobao X. Chen	17	2208

7590 04/15/2005

Docket Administrator (Room 3J-219)
Lucent Technologies Inc.
101 Crawfords Corner road
Holmdel, NJ 07733-3030

EXAMINER

KADING, JOSHUA A

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,175

Applicant(s)

CHEN, XIAOBAO X.

Examiner

Joshua Kading

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 1,2,5 and 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11-6-02</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

Claims 1, 2, 5, and 7 are objected to because of the following informalities:

Regarding claim 1, line 6, "the mobile terminal" should be changed to --the

5 mobile node-- to avoid a lack of antecedent basis.

Regarding claim 1, line 8, "the packet" should be changed to --a packet-- to avoid a lack of antecedent basis.

Regarding claim 1, lines 8-9, "the destination" should be changed to --a destination-- to avoid a lack of antecedent basis.

10 Regarding claim 2, line 2, "the current" should be changed to --a current-- to avoid a lack of antecedent basis.

Regarding claim 5, line 2, "the mobile" should be changed to --a mobile-- to avoid a lack of antecedent basis.

15 Regarding claim 7, line 5, "the MN Care" should be changed to --the mobile node Care-- because there is no indication in prior claims that indicates what "MN" stands for.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

20 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5

Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent 6,501,746 B1, Leung.

Regarding claim 1, Leung discloses, "a method of operating a third generation
10 mobile telecommunications system in which packets are addressed to a mobile node
which is currently associated with a foreign network and which is communicating with a
correspondent node (*figure 1*), comprising the steps of: setting up a home agent in the
correspondent node (*figure 1, element 8 where element 8 acts as a correspondent node*
because it is in communication with the mobile node and thus corresponding with the
15 *mobile node*); allocating a Care of Address for the mobile node in the foreign network
(*figure 2, element 208*); changing a packet header at the correspondent node so that a
destination address is the Care of Address (*figure 2, elements 226 and 228*); and
providing a mobile node identifier whereby route optimization is provided (*figure 2,*
element 226)."

20

Regarding claim 2, Leung discloses, "a method according to Claim 1 in which the
Care of Address represents a current location of the mobile node (*col. 6, lines 61-64*)."

Regarding claim 3, Leung discloses, "a method according to Claim 1 in which the Care of Address is the address of a foreign agent in the foreign network (*col. 2, lines 40-42*)."

5 Regarding claim 4, Leung discloses, "a method according to Claim 3 in which the foreign agent stores a mapping table of mobile nodes and mobile node identifiers (*figure 14, element 1402 as read in col. 15, lines 66-col. 16, lines 1-4*)."

 Regarding claim 5, Leung discloses, "a method according to Claim 4 in which,
10 when a packet is received by the foreign agent, the foreign agent looks at its stored mapping table to locate a mobile node for which the packet is destined (*col. 16, lines 57-60*)."

Claim Rejections - 35 USC § 103

15 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

20 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

 Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Leung in view of "Mobile Internet Access and QoS Guarantees Using Mobile IP and
25 RSVP with Location Registers," Jain et al. (Jain).

Regarding claim 6, Leung discloses the method of claim 1. However, Leung lacks what Jain discloses, "providing Quality of Service for the mobile in which an end-to-end Quality of Service enquiry message is sent from the correspondent node to the mobile node and a Quality of Service response message is returned hop-by-hop to the correspondent node (pg. 1690, right column, 2nd full paragraph, lines 3-pg. 1691, left column, 1st paragraph, lines 1-4, where in this case, the source node is the same as the correspondent node and the destination node is the same as the mobile node)." It would have been obvious to one of ordinary skill in the art at the time of invention to include the QoS enquiry and response for the purpose of establishing a path meeting the requirements of the QoS enquiry. The motivation for making sure a path meets the QoS requirements is so that subsequent packets sent across the path can take advantage of the guaranteed resources (Jain, pg. 1691, left column, 1st paragraph, line 3-4).

Regarding claim 7, Leung discloses the method of claim 1. However, Leung lacks what Jain discloses, "providing Quality of Service for the mobile in which an end-to-end Quality of Service enquiry message is sent from the mobile node to the correspondent node (pg. 1690, right column, 2nd full paragraph, lines 3-pg. 1691, left column, 1st paragraph, lines 1-4, where in this case, the source node is the same as the mobile node and the destination node is the same as the correspondent node), the mobile node having a built-in Quality of Service proxy server, and the proxy server changing the packet header source address to the mobile node Care of Address (pg. 1690, left column, 3rd paragraph, lines 7-pg. 1690, right column, 1st paragraph, lines 1-3

and 13-16)." It would have been obvious to one of ordinary skill in the art at the time of invention to include the QoS enquiry and response for the purpose of establishing a path meeting the requirements of the QoS enquiry. The motivation for making sure a path meets the QoS requirements is so that subsequent packets sent across the path can take advantage of the guaranteed resources (*Jain*, pg. 1691, left column, 1st paragraph, line 3-4).

Regarding claim 8, Leung and Jain disclose the method of claim 6. However, Leung lacks what Jain further discloses, "the Quality of Service is Resource reSerVation Protocol (pg. 1690, right column, 2nd full paragraph, lines 3-10)." It would have been obvious to one of ordinary skill in the art to have the QoS consist of RSVP for the same reasons and motivation as in claim 6.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 3, 6, 7, and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 5, 2, 1, and 9 respectively of U.S. Patent No. U.S. Patent 6,829,483 B2, Chen. Although the conflicting claims are not identical, they are not patentably distinct from each other

5 because Chen discloses a narrower version of what is disclosed in the instant application (specifically claim 1). Chen further adds the "sending a QoS enquiry message...and sending a QoS response." Although the sending of QoS enquiry and response messages is not disclosed in the independent claim of the instant application, it would have been obvious to one of ordinary skill in the art at the time of invention to
10 not include the enquiry and response messages because they are not necessary for the invention as disclosed in the instant application to work. That is to say, the invention in the instant application and the invention in Chen are directed to the same underlying subject matter and the adding of QoS enquiry and response messages only adds additional functionality to the invention in Chen, it does not change the way the core
15 invention works. The motivation for not using a QoS scheme would be to not waste time and resources reserving a path (which might not even be available) that is needed to satisfy the QoS requirements (*Chen, col. 3, lines 60-63 where there is added complexity by the use of RSVP*).

20 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Kading whose telephone number is (571) 272-3070. The examiner can normally be reached on M-F: 8:30AM-5PM.

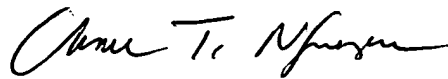
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (571) 272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

- Information regarding the status of an application may be obtained from the
- 5 Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic
- 10 Business Center (EBC) at 866-217-9197 (toll-free).



Joshua Kading
Examiner
Art Unit 2661

April 7, 2005



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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600